UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Hisense USA Corporation
Petitioner

v.

Brightplus Ventures LLC
Patent Owner

Patent No. 9,605,835
Filing Date: February 2, 2015
Issue Date: March 28, 2017
Title: SOLID-STATE LUMINAIRES FOR GENERAL ILLUMINATION

*Inter Partes* Review No. IPR2023-01168

# JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74

## I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner Hisense USA Corporation ("Hisense") and Patent Owner Brightplus Ventures LLC ("Brightplus") jointly move to terminate this *inter partes* review proceeding in light of the parties' settlement of their dispute related to the subject patent, U.S. Patent No. 9,605,835 ("'835 patent"). The filing of this Joint Motion was authorized by the Board in its email of January 3, 2025. The parties are submitting this joint motion to terminate this proceeding, along with a true copy of the related Settlement Agreement (Ex. 1037). Given that Hisense is the only Petitioner in this *inter partes* review proceeding, the Settlement Agreement effectively resolves all disputes related to the '835 patent, and this entire proceeding should be dismissed as to both Petitioner and Patent Owner.

## II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On December 30, 2024, Petitioner and Patent Owner reached an agreement resolving the underlying dispute in the above-captioned *inter partes* review. Ex. 1037. The challenged patent is also at issue in the following district court case: *Hisense USA Corporation v. Brightplus Ventures LLC*, No. 1:22-cv-02774-TCB (N.D. Ga.).

In the Settlement Agreement, the parties have agreed to dismiss the district court litigation. Accordingly, termination of this IPR proceeding is appropriate

because all disputes between the parties regarding the ’835 patent have been resolved.

In parallel with this joint motion, additional joint motions to terminate are being filed in other *inter partes* review proceedings between the parties. Those other *inter partes* review proceedings are:

- IPR2023-01311 involving U.S. Patent No. 8,177,382
- IPR2023-01385 involving U.S. Patent No. 7,690,812
- IPR2023-01401 involving U.S. Patent No. 8,941,331
- IPR2023-01410 involving U.S. Patent No. 8,294,075
- IPR2023-01411 involving U.S. Patent No. 7,872,705
- IPR2023-01412 involving U.S. Patent No. 8,330,710

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Settlement Agreement resolving the dispute in the above-captioned *inter partes* review is being submitted as Ex. 1037 by the parties, along with a request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). The parties hereby certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

This joint motion is being made before the Office "has decided the merits of the proceeding." 35 U.S.C. § 317(a). Motions to terminate based on a joint request are routinely granted in the pre-final written decision time frame. Here a final written decision has not issued, and termination is appropriate. Additionally, as discussed above the parties have settled all disputes in this proceeding as well as other disputes in other *inter partes* review proceedings and the district court case referenced above. Finally, termination of these proceedings furthers the purpose of *inter partes* review proceedings by encouraging parties to settle disputes in an efficient and less costly manner. For at least these reasons, Patent Owner and Petitioner submit that termination of this *inter partes* review proceeding is appropriate.

Dated: January 3, 2025

*/s/ Matias Ferrario*
Matias Ferrario, Lead Counsel
Reg. Reg. No. No. 51,082

Kilpatrick Townsend & Stockton LLP
1001 West Fourth Street
Winston Salem, NC 27101
Office: (336) 607-7475
Fax: (336) 734-2657
mferrario@ktslaw.com

Counsel for Petitioner

*/s/ Neal Massad*
Neal Massad, Lead Counsel
Reg. No. 54,296

Ni, Wang & Massand, PLLC
8140 Walnut Hill Lane, Suite 500
Dallas, Texas 75231
Office: (972) 331-4600
Fax: (972) 314-0900
nmassand@nilawfirm.com

Counsel for Patent Owner

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of this **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R.** has been served via email on the following:

hni@nilawfirm.com
twang@nilawfirm.com
nmassand@nilawfirm.com

Dated: January 3, 2025

By: */s/ Matias Ferrario*
Matias Ferrario
Registration No. 51,082